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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,062	01/29/1999	THOMAS GRAF	2565/45	6866

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NEW YORK, NY 10004

EXAMINER

CHOI, STEPHEN

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 08/27/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/240,062

Examin r

Stephen Choi

Applicant(s)

GRAF ET AL.

Art Unit

3724

-- The MAILING DATE f this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003 .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation requiring the recited steps to be performed sequentially is not supported by the specification. For example, steps (c) and (d) in claim 1 and the releasing and gripping steps recited in claim 5 do not appear to happen sequentially.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what step is set forth by "sequentially". Some of the steps do not appear to happen sequentially.

Claim Rejections - 35 USC § 102

Art Unit: 3724

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 5, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Koehler (US 1,965,464).

Koehler discloses all the recited steps of the invention including:

- a) transporting a fiber bundle strand using at least one feed element (52, 53);
- b) cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length (74, 75);
- c) releasing the unbound partial bundles from the at least one feed element (page 2, lines 72-81);
- d) gripping the unbound partial bundles using at least one gripping element (65, 66);
- e) releasing the unbound partial bundles from the at least one gripping element (page 2, lines 82-92);
- f) placing the unbound partial bundles having the same length in a first collection trough (26) of a collection device (25);
- g) rotating the collection trough device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough (page 2, lines 36-39). Element 26 adjacent to the first collection trough

(26) is construed as being "a further collection trough". It is also noted that the claim does not preclude a step of bounding partial bundles.

Furthermore, the claim does not call for a step of rotating the collection device while the unbound partial bundles in the first collection trough remains unbounded.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Koehler (US 1,965,464).

Koehler discloses the invention substantially as claimed including a step of repeating steps a) to f) for the required number of unbound partial bundles (page 2, lines 36-39). Koehler fails to disclose repeating the steps a) to f) until a required thickness of the fiber bundle is obtained. However, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to repeat the steps a) to f) until the required thickness of the fiber bundle is obtained (e.g., a required manufacturing amount of bundles) in order to complete a required amount for each containers or collection boxes. It is noted that the claim does not call for the required thickness of the bundles in each through. It is noted that the claim does not preclude a step of bounding partial bundles. It merely requires steps a)

Art Unit: 3724

to f) being repeated to place the required number of unbound partial bundles in the first collection trough. Each element 26 is construed as being "a first collection trough" of the collection device (25).

Response to Arguments

9. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 10 June 2003 with respect to claim 5 have been fully considered but they are not persuasive.

Applicants contend that Koehler does not disclose a step of placing the unbound partial bundles having the same lengths in a collection trough until a required thickness of the fiber bundle is obtained. As set forth above, Koehler does teach the step of placing the unbound partial bundles having the same length in a first collection trough (26) of a collection device (25). Furthermore, the claim does not call for the step of placing the unbound partial bundles having the same lengths in a collection trough until the required thickness of the fiber bundle is obtained.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3724

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Choi whose telephone number is 703-306-4523. The examiner can normally be reached on Monday thru Friday between 9am and 5pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302 (703-872-9303 for after final). Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

sc
August 22, 2003

A handwritten signature in black ink, appearing to read 'Stephen Choi', is positioned above the printed name.

Stephen Choi
Patent Examiner